

Invention Disclosure Information

Detailed information on the invention disclosure process, NIST patent policies, and patent applications procedures are available on the NIST web site at:

<http://www-i.nist.gov/div222/InventorHandbook/handbook/indexa.htm>. The site should answer many of the questions you may have regarding both this disclosure sheet and the process as a whole.

NIST requires the following information from you so that:

- Your management can make an informed judgment as to whether seeking patent protection for your invention is appropriate; and
- The NIST Counsel's office can perform an Employee Rights Determination to determine which organizations or individuals may have an ownership interest in the invention, and whether or not preferential licensing rights may exist; and
- The Office of Technology Partnerships can prepare a recommendation on how to best make the invention available to U.S. industry, and if appropriate, prosecute a patent application.

Any other relevant information you may be able to provide on the invention, the circumstances under which it took place, prior art of which you may be aware (publication, patents and the like), and potential uses/users is certainly welcome.

The attached information sheets use the term "inventor," and "invention" for convenience.

Have I conceived an invention?

Before completing the form, take a moment to consider whether your technology is sufficiently developed to be an "invention." Normally, to be considered an invention, a technology must be fully conceived. Being conceived means far more than just having an idea. An invention is fully conceived only when "the complete performance of the mental part of the inventive act [is finished]." When an invention is conceived, all that remains to be accomplished in order to make the invention work is construction, not invention. A conception is the formation in the mind of the inventors a definite and permanent idea of the complete and operative invention. A good test is whether you can describe the invention well enough that one with ordinary skill in the art (such as yourself) could take the description and reduce the invention to practice without undue experimentation.

Who is an Inventor?

An inventor is one who contributes to the conception of the invention. Each inventor should be able to look at the claims of an invention (or look at the novel features of an invention) and point to his or her contribution. One who merely reduces an invention to practice, or one who merely acts under the instruction of the inventor, is not normally an inventor of the technology. Those assisting in reducing the invention to practice under the guidance and/or instruction of others are often critical to the overall process, but should not be included as inventors if they did not also participate in the conception of the invention. It may be helpful to keep in mind that inventorship is not like authorship. Including someone as an author on a paper describing the invention does not mean that they should automatically be listed as an inventor as well.

What constitutes Public Disclosure?

Public Disclosure(s), or public use and/or sale (This may bar obtaining a foreign patent unless an application is filed prior to disclosure or a U.S. patent unless an application is filed within one year of the disclosure.)

Public disclosure of the invention occurs when it appears in written form in a publication or is made available to others on an unrestricted basis, even if not in writing, such as in an oral presentation at a meeting, in sufficient detail to enable one of ordinary skill in the art to make and use the invention. Published pre-prints or abstracts of a paper for a scientific meeting, or a degree thesis are usually considered public disclosures. Further, a disclosure

to an academic colleague, to an individual not employed by NIST, for peer review of an article, or presentation at a Gordon Conference may or may not be a public disclosure, depending on the existence of a non-disclosure agreement between the parties.

An “enabling” disclosure is one that provides enough information for a person of ordinary skill in the scientific art to practice the invention without undue experimentation.

A public disclosure, written or oral, can be used as prior art by an examiner evaluating a patent application if enough of the invention is disclosed to enable a person of ordinary in the relevant field to put the invention into practice. Such disclosure can also be used in courts to invalidate an issued patent.

Inventor Information

If there is more than one inventor, a NIST employee-inventor point of contact should be identified. The contact is responsible for completing the attached sheets, with the exception of the individual “Inventor Information Sheets.” The contact should attach all relevant appendices to the invention disclosure sheet and submit them through his/her NIST management.

An Inventor Information sheet needs to be completed and attached for **each of the inventors**.

Should your OU Director decide to have a patent application filed, it is very important that the U.S. Patent and Trademark Office be provided with accurate information on inventorship. Incorrect information on inventorship may affect the validity of a patent.

Invention Description

(To be completed by the point of contact inventor)

Guidelines

The following guidelines are provided to assist you in preparing description of the invention. If NIST elects to apply for a patent, the document that you submit as an invention disclosure will be used by many people throughout the prosecution of the patent application. Please include the items below:

1. Title of the invention.
2. Abstract of the disclosure.
3. In general terms, the purpose and object of the invention.
4. Describe the invention in sufficient detail that anyone with ordinary technical skill would be able to understand the invention. Particularly point out the novel features of the invention.
5. If the invention is a device, include appropriate drawings and sketches that will enable others to understand the device.
6. If the invention is a process, describe each step in the process and what the process accomplishes.
7. If the invention is a composition of matter, describe the composition, its physical and chemical properties, how it is prepared, and include any test data which shows its usefulness. Include structural formulas for novel chemical compounds.
8. Describe the competing technologies and point out how the invention differs from these technologies, what problems it overcomes and advantages it offers.
9. Discuss potential commercial applications for the invention.
10. Provide any additional material (such as photographs, reports, publications, and references to texts or other information material) which may be helpful to an understanding of the invention. Please identify and indicate the specific relevance of each.

Include relevant prior art or other technical relevant material.

NIST Invention Disclosure

(To be completed by the point of contact inventor)

Invention Title

Names of Inventors (list the names of *all inventors*)

Date that the invention was conceived (as described above): , as recorded in Laboratory
Notebook number , page ; and/or evidenced in meeting notes, or other in other tangible form.

Has the invention been reduced to practice? Yes No

Dates over which the invention was reduced to practice: from to .

If you plan to continue research to reduced the invention to practice, over what time period?

Disclosure

Please provide the following information as appropriate:

An enabling disclosure was published in on .

An enabling disclosure was submitted to
for publication on (if known).

An enabling disclosure was posted on the web at (site address)
on .

An enabling disclosure was/will be made in a presentation at
on .

An enabling disclosure was/ will be made to the following organizations or non-Federal employees
on at .

An enabling disclosure of the invention was included in grant/contract application number
to on .

A non-enabling disclosure of the invention was made on . Please explain.

NIST Invention Disclosure

(To be completed by point of contact inventor)

Was the invention conceived and/or reduced to practice under a CRADA? Yes No

If yes, please provide the CRADA number

and collaborator

Was the invention conceived or reduced to practice under a Grant, Contract or Cooperative Agreement or with funds from any source other than NIST? Yes No

If yes, please provide the agreement number

funding provider

and funding recipient

Were any of the inventors Guest Researchers at the time of their participation in the conception of the invention? Yes No

If yes, please indicate who and the name of their home organization(s).

Was the invention conceived with financial support from ATP intramural funding? Yes No

If yes, please provide the title and duration of the project.

Was the invention conceived under an NIST Industry Fellow Agreement? Yes No

If yes, please provide the number, title and the industrial partner.

Was the invention conceived and/or reduced to practice during an informal collaboration? Yes No

If yes, please provide a brief description of the circumstances.)

To the best of your knowledge, the following patents, patent applications, publications directly relate to the disclosed invention:

Name

Title

Inventor Signature

Date

Signature_____
Division Chief

Date

Signature_____
Laboratory Director

Date

NIST Invention Disclosure – Inventor Information

(* To be completed by each inventor, individually)

1. Invention Title:
2. Name, address, phone, e-mail.
3. If you are a NIST employee: Division number: _____ Dates of NIST employment: from _____ to _____
4. If you are not a NIST employee: Name and address of your employer.
5. Citizenship:
6. Did you work on the invention before you came to or were employed by NIST? Yes No
If so, please briefly describe what work was done:
- If you are not a NIST employee, what is your relationship to NIST (e.g. informal collaborator, Guest Researcher, contractor, Intergovernmental Personnel Act agreement, etc.)?
- a. If you are not a NIST employee, please attach a copy of the agreement, if any, under which you are working at NIST and/or collaborating with NIST staff:
- b. Was your work on this invention funded in whole or in part by funds from the Federal Government? Yes No
7. Having read the NIST Invention Information Sheet, do you believe that you are an inventor of the disclosed invention? Yes No
a. If so, were you a NIST employee when you conceived or participated in the conception of the invention? Yes No
8. Having read the NIST Invention Information Sheet, do you believe that each of the listed inventors contributed to the conception of the invention? Yes No
9. Were you a NIST employee when you participated in the reduction to practice? Yes No
10. Please briefly describe your role in creating the invention.
11. Are you aware of any disputes over inventorship of the disclosed invention? Yes No
12. Please check all of the following that apply to this disclosure. The invention:
is directly related to my official duties
was made during working hours
was made with a contribution of the government of facilities, equipment, materials, funds, information, or time or services of other government employees on official duty.

Signature

Date